REMARKS

Claims 1-11 are pending. Claim 12 is added herein. Accordingly, claims 1-12 are at issue.

Claims 1-11 stand rejected under 35 U.S.C. §112, as being indefinite.

It is noted that there are several objections to claim 1 for failure to provide sufficient antecedent basis for various limitations thereof. In addition, it is acknowledged that original claim 1 in certain aspects lacked a desired level of clarity. Accordingly, claim 1 has been extensively amended to address the antecedent basis problems noted in the Action and to provide more clarity thereto to meet the requirements for more particularly pointing out and distinctly claiming the subject matter thereof. Thus, it is believed the indefiniteness rejection of claims 1-11 is obviated.

Claims 1-11 stand rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 6,298,327 to Hunter et al. in view of U.S. Patent No. 6,018,714 to Risen et al.

The rejection, as it may apply to the claims presented herein, is respectfully traversed.

Claim 1 is directed to a system for developing commercially valuable intellectual property rights and calls for a communication path, an idea database, and a structured database. More particularly, the communication path allows independent sources that includes individuals or organizations from a plurality of remote locations to send information packets to a predetermined host for evaluation. The host selects information packets to be included in the idea database. The idea database is accessible by expert review boards of the host. The review boards are each associated with a specific field of endeavor and develop the information packets into commercially valuable forms thereof. The structured database includes proprietary technology that is based on the commercially valuable forms of the information packets and is accessible to potential purchasers of rights to the proprietary technology to generate maximized revenue for the sources of the information packets and the host. The cited references do not suggest the system of amended claim 1 including a

communication path, an idea database of selected information packets and structured database of proprietary technology, as described above.

The '327 patent to Hunter et al. is directed to software that assists and guides inventors in authoring their invention disclosures. The software is intended to optimize the invention disclosures authored by the inventors by different Help topics in the software that the inventor can access to work their way through completing the different sections of the invention disclosure document. Hunter et al. disclose that the software includes "knowledgebases (typically rules) and an inference engine that uses the rules and user input to make (or support) decisions." (Column 21, lines 61-63) Hunter et al. provide a list of classes of expert objects in Table 6, at column 22, lines 11-29. The expert object classes include assessments with respect to patentability in various jurisdictions, and marketability. An example of operation of the inference engine using rules for the PTO patentabiliy assessment is described at column 26, line 54 to column 28, line 27 and shown in Table 12. Thus, Hunter et al. suggest that invention disclosures authored using their system will be improved in terms of their ability to serve the distinct purposes for which they may be prepared.

The items identified in the Action, i.e. patentability assessments 51, marketability assessments 53 and experts 55, are part of hierarchy graph (FIG. 3) of expert classes and, as such, are simply software tools that guide inventors as they author their disclosures, as discussed above. These software tools are not the same as expert review boards as asserted in the Action.

Accordingly, it is apparent that Hunter et al. fail to teach many features of the system recited in claim 1. For instance, Hunter et al. fail to teach a system having both: (1) an idea database that is accessible by expert review boards whose task is to further develop selected information packets into commercially valuable forms, and (2) a structured database of proprietary technology selectively accessible to potential purchasers of rights in the technology.

More specifically, Hunter et al. do not teach or contemplate an idea database that is constructed from information packets selected by a host, as called for in claim 1. Instead, inventors simply fill out invention disclosures utilizing the software taught by Hunter et al. At best, Hunter et al. suggest that these disclosures will be reviewed by technology managers and patent professionals to decide whether to further invest in protecting the invention, and whether patent protection is appropriate (see, e.g., column 2, lines 47-54). Furthermore, Hunter et al. do not suggest that such an idea database is then to be made accessible to expert review boards for the purpose of developing the selected information packets into commercially valuable forms, as required in claim 1. As previously discussed, the "experts" referenced by Hunter et al. are not expert review boards but are software help tools that guide an inventor in completing an invention disclosure. These tools in no way transform or further develop the underlying invention disclosure, and Hunter et al. do not suggest that the inventions are further developed by their software. Thus, while Hunter et al. may disclose a database for invention disclosures, they certainly do not teach selecting information packets for an idea database or having those idea packets further developed into commercially valuable forms by expert review boards, as called for in claim 1.

In addition, Hunter et al. is completely silent with respect to the structured database recited in claim 1. More particularly, there is no database disclosed or suggested by Hunter et al. that would be comprised of proprietary technology based on the commercially valuable forms of the information packets. As discussed, Hunter et al., do not disclose further developing information packets into commercially valuable forms and then organizing proprietary technology that is based on the developed, commercially valuable forms of the information packets in a structured database separate from the idea database. For instance, once the invention disclosures in Hunter et al. have been completed and then made the subject of patents, there is no discussion in Hunter et al. of how to exploit those patents for commercial gain. In contrast, claim 1 states that the proprietary technology database is made

accessible to potential purchasers of rights to the technology to generate maximized revenue for the sources of the information packets and the host.

Risen, Jr. et al. teach a method of providing intellectual property insurance that is useful during due diligence activities that occurs as a result of mergers or acquisitions. While Risen, Jr. et al. do disclose the need to determine the value of an intellectual property asset, this is in the context of determining a suitable insurance premium for the intellectual property asset at issue such as in a due diligence analysis. Thus, Risen, Jr. et al. do not teach anything in the way of providing the recited structured database of proprietary technology that is based on commercially valuable forms of information packets as developed by expert review boards. Consequently, since there is no suggestion of the recited structured database of proprietary technology in Risen, Jr. et al., they certainly cannot and do not teach or suggest making such a structured database accessible to potential purchasers of rights to the proprietary technology to maximize revenue for the sources of the information packets as well as the host, as called for in claim 1.

Moreover, there is nothing in either of the relied-upon references that would suggest or provide motivation for their combination. Further, even if combined, they would not arrive at the subject matter of claim 1. As discussed, neither Hunter et al. or Risen, Jr. et al. disclose the structured database recited in claim 1. Hunter et al. are not concerned with selling of rights in intellectual property assets and instead focus on improving the authoring of invention disclosures, and Risen, Jr. et al. are silent with respect to obtaining and further developing information packets, and only disclose the goal of appropriately valuing selected intellectual property assets to determine an insurance premium therefor. The disclosure of a need to determine a value for an intellectual property asset by Risen, Jr. et al. without more suggests little in the way of a combination with the teachings of Hunter et al. to provide the structured database of proprietary rights, which neither teach, along with a communication path for receiving invention disclosures, and an idea database of information packets that are

further developed by expert review boards, as required for the system of claim 1. Accordingly, it is believed that claim 1, and claims 2-12 which depend therefrom, are allowable over the relied upon art.

Based on the foregoing, reconsideration and allowance of claims 1-11, and consideration and allowance of added claim 12, are respectfully requested.

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